

Neifeld Docket No: DEATON-18-USC1

Application/Patent No: 08/935,116

USPTO CONFIRMATION NO: 8230

File/Issue Date: 9/22/1997

Inventor/Title: DEATON/System, Method and Database for Processing Transactions

Examiner/ArtUnit: ALVAREZ, Raquel/3622

ENTITY STATUS: LARGE

PRIORITY CLAIM - FIRST SENTENCE OF SPECIFICATION: This application is a continuation of pending U.S. Application Serial No. 08/117,951 filed August 30, 1993 by David W. Deaton and Robert S. Wood entitled "Check Transaction Processing Method and System," pending; which is a continuation of U.S. Application Serial No. 07/826,255 filed January 24, 1992 by David W. Deaton and Robert S. Wood entitled "Check Transaction Processing Method and System," abandoned; which is a continuation of U.S. Application Serial No. 07/345,475 filed May 1, 1989 by David W. Deaton and Robert S. Wood entitled "Check Transaction Processing Method and System," abandoned.".

RESPONSE TO NOTICE THAT CERTAIN REFERENCES WERE NOT CONSIDERED

Attachment 1 is a copy of the office communication mailed September 10, 2009, in which the examiner states on page two: "Please find attached IDS filed on 11/19/1998.". The markings on the attached copy of the IDS filed 11/19/1998 indicate that the examiner did not consider the following US patents: 4,825,045, 4,833,308, 5,245,164, 5,245,533, 5,249,044, 5,251,152, and 5,253,345; and the following documents listed as "Other Documents": "A New Dimension in Marketing", "What's New in Supermarket Promotion - Tracking Shoppers With Personal Codes"; and "In This Computer Age, Who Needs Coupons?". Attachment 1 also includes PTO-1449 forms which state that these references were "not considered in parent applications and no fee per 37 CFR 1.97 for consideration in parent app." See, for example, the office communication mailed September 10, 2009, sheet 1 of 13, footnote (2).

The appellant reviewed a copy of the file history of parent application 08/117,951. The January 12, 1995 office action in 08/117,951 notes on the front page that "THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:" "Notice of Art Cited by Applicant, PTO-1449". I note that 11 pages of PTO-1449 forms were immediately following the office action in the file history. Based on these facts, I believe that 11 pages of PTO-1449 forms, which were immediately following the office action in the file history, were the PTO-1449's to which the January 12, 1995 office action in 08/117,951 referred. Based on these facts, I believe that the

January 12, 1995 office action confirms USPTO receipt of the prior art citations contained on the 11 pages of PTO-1449 forms. Attachment 2 is a copy of the office action in application 08/117,951 mailed January 12, 1995 and a copy of the 11 pages of PTO-1449 forms.

In the file history I reviewed, the 11 pages of PTO-1449 forms are contained after the beginning of item 36 and before the beginning of item 37. Item 36 is indicated by a bookmark to be a "rejection" and starts with an office action. This indicates to me that the examiner included in the January 12, 1995 office action (bookmark 36), 11 pages of PTO-1449 forms, which cite the following US patents: 4,825,045, 4,833,308, 5,245,164, 5,245,533, 5,249,044, 5,251,152, and 5,253,345; and cite the following documents listed as "Other Documents": "A New Dimension in Marketing", "What's New in Supermarket Promotion - Tracking Shoppers With Personal Codes"; and "In This Computer Age, Who Needs Coupons?". In any case, the PTO date stamps on the 11 pages of PTO-1449 forms indicate that the 11 pages of PTO-1449 forms had been received by the USPTO.

Since the 11 pages of PTO-1449 forms were apparently filed in the 08/117,951 application, even if they were not considered in that application, they should have been considered in the continuation application thereof, as noted in MPEP 707.05 (at [http://www.uspto.gov/web/offices/pac/mpep/documents/0700\\_707\\_05.htm](http://www.uspto.gov/web/offices/pac/mpep/documents/0700_707_05.htm)), which states that "In all continuation and continuation-in-part applications, the parent applications should be reviewed for pertinent prior art."

For the reasons presented above, the appellant requests that the examiner consider as prior art in application 08/935,116, the following US patents: 4,825,045, 4,833,308, 5,245,164, 5,245,533, 5,249,044, 5,251,152, and 5,253,345; and the following documents listed as "Other Documents": "A New Dimension in Marketing", "What's New in Supermarket Promotion - Tracking Shoppers With Personal Codes"; and "In This Computer Age, Who Needs Coupons?"

Respectfully submitted,

Date: 10/27/2009

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ATTORNEY OF RECORD

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